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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,853	08/21/2003	Randall A. Addington	1081003	1852
24253	7590	07/25/2005	EXAMINER	
JOEL I ROSENBLATT 445 11TH AVENUE INDIALANTIC, FL 32903			PIERCE, WILLIAM M	
			ART UNIT	PAPER NUMBER

3711

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/604,853

Applicant(s)

ADDINGTON ET AL.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**. ~~2b) ☒ This action is non-final.~~
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 3, 15 and 20-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action..

Claims 2, 3, 15 and 20-33 claims the combination of a counter force or a frictional force. In *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980), held that "the laws of nature, physical phenomena, and abstract ideas have been held not patentable." Frictional and inertia forces being claimed in combination here are considered to be laws of nature and physical phenomena and not patentable.

With respect to this rejection, claim 1, for example, most broadly reads as a "system...for producing a force..." Such inertial forces that applicant is claiming to produce by his system is not patentable subject matter as set forth above. Like claiming a system for producing forces between a finger and surface hereat, Einstein could not patent his celebrated law that  $E=mc^2$  nor could Newton have patented the law of gravity. Applicant maintains that his claims are written in means plus function language to argue this grounds for rejection. However, the issues of 101 and 112 are separate and distinct and merely using means plus function language does not make the claimed combination statutory. Applicant's claims are rejected under 101 as being nonstatutory for claiming a system for producing a force and not for drafting the claims in means plus function language.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 15 and 20-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claims 2 and 3 are unclear in that it claims a force that is created during an intended use of a bowling ball. One cannot determine the metes and bounds for the claim since its scope will change depending upon how a bowling ball is delivered. For example, Calentines device would produce "counter forces at an angle" when being used due to the lift and rotation of the wrist during the delivery of a bowling ball. However, the

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same structure may or may not generate such forces when the ball is merely being held at rest by a bowler prior to rolling the ball or when throwing a ball straight on at the pins without producing any spin on the ball. Applicant again argues that his claims are proper since they are written in means plus function language. However, this grounds for rejection never set forth that using such language was improper. The rejection set forth that the claims were indefinite. The indefiniteness is due to the claims not pointing out and distinctly claiming the subject matter which the applicant regards as his invention as required by the second paragraph of 35 USC 112. Since the forces encountered during the release of a bowling ball depend on many inconsistent variables it is impossible for one to determine the metes and bounds of these claims for infringement purposes. As such these claims remain rejected under 112.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-16, 18, 19 and 21-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Calentine.

As to claims 1 and 8-16, 18 and 19, Pg. 17 of applicant's specification states that the finger pad, such as 10 shown by Calentine, can be mounted by way of a glove as is shown by Calentine's 44. 14 is the second means for mounting and 70 and 18 are the first and second means for co-acting. As to claims 2 and 3 Calentine inherently produces the frictional and inertial forces experiences between a bowling ball and a bowlers fingers while bowling. As to claim 4, at 50 of the extension is considered to be a means for limiting the depth of insertion. Applicant's specification limit the scope of such a means to a raised surface as that which is shown at 50. As to claims 6 and 7, 24 is a hemisphere protrusion and 70 is the groove indentation that is hemisphere in cross-section. Claims 21-33 are interpreted as set forth above with respect to the preceding claims. The "forces" acting in the delivery of a bowling ball that interact between a finger, an insert and the bowling ball are inherent in Calentine.

Applicant argues that Calentin does not disclose the means plus function. However, as set forth above, such inertial forces considered inherent in the delivery of a bowling ball on a finger protector like the one used by Calentine. Under the principles of inherency, once a reference teaching a product appearing to be substantially identical is made as a basis of a rejection, the burden is shifted on the applicant to show that these limitations are not present in the prior art.

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"[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977))

Since applicant has not met such a burden in his remarks, this rejection remains.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calentine.

While Calentine fails to show covering of the finger tip. Finger tip gloves and gloves without finger tip are well known depending upon the users desired amounts of protection. In bowling full finger inserts are known as shown by Pugh. To have included a means for covering the finger tip of Calentine would have been obvious in order to afford protection to the finger tip during bowling. As to claim 20 increasing the number of interacting inserts 28 and slots 70 of Calentine would have been an obvious matter of duplication of parts. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Applicant argues that this rejection is without support in fact. However, a prima facie case of obviousness has been explicitly set forth in the grounds of rejection that covering the finger tip of Calentine would have been obvious in order to protect the tip of the finger. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a prima facie obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flathead screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flathead screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not "motivate" use of Phillips head screws in place of flathead screws. What must be established to sustain an obviousness rejection is a legally sufficient rationale as to

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why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant); In the instant case, one skilled in the art viewing Calentine and wishing to afford protection to the finger tip would find it obvious to cover it.

**Conclusion**

Applicant's arguments filed 4/27/05 have been fully considered but they are not persuasive for the reasons set forth above in the grounds for rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



**WILLIAM M. PIERCE  
PRIMARY EXAMINER**